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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/671,361

09/25/2003

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13768.810.87

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7590

08/29/2008

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EXAMINER

THERIAULT, STEVEN B

ART UNIT

PAPER NUMBER

2179

MAIL DATE

DELIVERY MODE

08/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/671,361

Applicant(s)

DANIELI, DAMON V.

Examiner

STEVEN B. THERIAULT

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-10, 12 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12, 15-20 and 25 is/are allowed.
- 6) ☒ Claim(s) 1, 4-10, 21-24, 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the following communications: amendment filed 10/30/2007.

This action is made Final.

2. Claims 1, 4-10, 12 and 15-29 are pending in the case. Claims 1 and 12 are the independent claims. Claims 2, 3, 11, 13, and 14 are the cancelled claims.

Allowable Subject Matter

3. Claims 12, 15-20 and 25 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of Ortel (see reference below) teaches a mechanism for visually indicating to a user on the display when another person is speaking during a conference or online chat. Ortel specifically teaches a process of adding a user indicator while the user is speaking and then removing the indicatory when they are done. The prior art of Lerner (see reference below) also teaches displaying an indicator when the user is speaking. Neither Ortel nor Lerner teaches displaying a gamertag as a form of visual identification. Neither Ortel nor Lerner teach displaying each of a muted icon, a bidirectional mute icon, a null icon and a hear-only icon to indicate to the user their communication capability or status. The prior art of Jenniges et al. 20040203766 teaches a mechanism for displaying icons that represent the communications capability of the user. However, no suggestion is mentioned that would provide for displaying more than one icon as Jenniges teaches displaying a single icon to communicate status. Further, none of the icons represent a null icon, hear-only icon, bi-directional icon or muted icon, as recited in the claims. The prior art of Giaimo et al. 6928329, assigned to the same, teaches a mechanism for allowing the user, during a game, to express verbal commands to control the access to multiple audio streams from other users during a game. The user can also select a series of push buttons to control the audio communications with another user. The system allows for input via a microphone but the system does not display the icons mentioned above. Therefore, the prior art of Ortel, Lerner, Jenniges, and Giaimo either alone or in combination do not suggest or disclose a system as recited in the claims.

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 of this application conflicts with claim 23 of Application No. 10/886,533. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 102

3. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 8-10, 24 are rejected under 35 U.S.C 102(e) as being anticipated by Ortel et al. (hereinafter Ortel) U.S. Publication No. 20040091086 filed Nov. 8, 2002.**

In regard to **Independent claim 1**, Ortel teaches a method for visually indicating a voice speaker to a listener in a context of a computing session, comprising the steps of:

- Obtaining a speaker identifier that identifies a voice speaker who is transmitting voice data (See Ortel Para 22 -23, 31). Ortel teaches identifying a user based on their voiceprint by matching the voiceprint to a table entry containing voiceprints.
- Associating the speaker identifier with a visual indicator indicating the voice speakers in the computing session (See Para 32, 35-36). Ortel teaches the identity of a user is displayed as a face, photograph, icon or caricature, which are visual indicators.
- Selectively and temporarily, only when the voice speaker is speaking, displaying the visual indicator and selectively and temporarily, only when the voice speaker is speaking, displaying the user name, and when the visual indicator and the user name are displayed, displaying the visual indicator and the user name adjacent to one another, to the listener to indicate the voice speaker who is speaking (See Para 35-36, 38 and 45 and Figure 3). Ortel shows the user can arrange the icons on the display. Ortel specifically shows the visual indicator and name of the user shown adjacent to one another in figure 3. Further, Ortel teaches the user name, face or icon is displayed **only** when the user is speaking (See Para 35), as Ortel teaches the purpose of indicating the speaking person is to indicate to the user when someone starts and stops speaking.

With respect to **dependent claim 8**, Ortel teaches the method further comprising modifying the voice data as a function of a status of at least one of the voice speaker and the listener in the computing session (See Para 44-46). Ortel teaches modifying and refining the stored voiceprint (voice data) in the table by adding new material to the voiceprint library during the computing session.

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With respect to **dependent claim 9**, Ortel teaches the method further comprising the step of mixing the voice data from the voice speaker with voice data from another voice speaker to provide the listener with a multi-voice communication (See Para 51). Ortel teaches merging audio signals from the participants.

With respect to **dependent claim 10**, Ortel recites a memory medium and substantially similar subject matter as claim 1 and is therefore rejected along the same rationale and reflects the stored machine instructions for carrying out the steps of Claim 1 (See Para 27-28).

With respect to **dependent claim 24**, Ortel teaches changing the visual indicator to show a moving mouth on a character controlled by the speaker (See Ortel Para 40, face with open mouth).

Claim Rejections - 35 USC § 103

5. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 4-7, 21, 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ortel et al. (hereinafter Ortel) U.S. Publication No. 20040091086 filed Nov. 8, 2002, in view of Lerner et al. (Hereinafter Lerner) U.S. Patent No. 6192395 issued Feb. 20, 2001.**

With respect to **dependent claim 4**, as indicated in the above discussion Ortel teaches each limitation of claim 1. Ortel teaches displaying all of the participants in a muted image because the system applies a highlighting to the user that is speaking and the highlighting will visually enhance the image of the user in contrast to the others. Nonetheless, Ortel is silent as to determining whether the listener has elected to hear voice communication from the speaker. However, Lerner teaches the visual state of the represented user displays an indication that the user has been removed from an event or privileges to speak through the medium have been revoked (See column 2, lines 35-45 and column 7, lines 17-40). Thus it would have been obvious to the skilled artisan at the time of the invention, having the teachings of Ortel and Lerner in front of them, to modify the visual indicator of Ortel to provide more visual information to the user via the displayed icon for the purpose of conveying to the user and other users that a particular person is not allowed to speak during the teleconference while displayed in the list of participants of a event (See column 2, lines 14-39 and column 1 3, lines 20-30).

With respect to **dependent claims 5-7, 26-27** as indicated in the above discussion Ortel teaches each limitation of claim 4. Ortel does not teach the method wherein the step of determining comprises at least one of the steps of: (a) determining whether the listener has muted voice communications from the voice speaker (b) determining whether the voice speaker provided evidence that the voice speaker is trusted by the listener, so that voice communications from the voice speaker are allowed to be heard by the listener. Ortel does not teach determining if the user is restricted from communicating as a result of an event during the session and revoking access to speak. However, Lerner teaches assigning privileges to users that can speak in a session and also the process of placing a person on hold and visually identifying when the user is on hold

(See column 3, lines 1-5 and 7 lines 17-40). Lerner also teaches the visual state of the represented user displays an indication that the user has been removed from an event or privileges to speak through the medium have been revoked, which is a muted state (See column 2, lines 35-45). Lerner teaches denying privileges to a user from speaking at a conference, which would prohibit a user from hearing the user (See column 7, lines 17-30). Learner teaches a determining whether the voice speaker is restricted from voice communication as a result of one of an event occurring in the computing session and a status of the computing session (See column 7, lines 17-30) because the system of Lerner determines if the user is away from the keyboard and as such is restricted from voice communication, thus is a system event. Learner also teaches an indicator will be displayed to a user that does not have access rights to join a conversation or that is denied from responding to a particular message (See column 7, lines 15-40). Lerner teaches the visual state of the represented user displays an indication that the user has been removed from an event or privileges to speak through the medium have been revoked, which can be to display the user is muted and does not have permission to speak (See column 2, lines 35-45 and column 7, lines 17-40). Thus it would have been obvious to the skilled artisan at the time of the invention, having the teachings of Ortel and Lerner in front of them, to modify the visual indicator of Ortel to provide more visual information to the user via the displayed icon for the purpose of conveying to the user and other users that a particular person is not allowed to speak during the teleconference while displayed in the list of participants of a event (See column 2, lines 14-39 and column 1 3, lines 20-30).

With respect to **dependent claim 21**, as indicated in the above discussion Ortel in view of Lerner teaches each limitation of claim 1.

Ortel does not expressly teach a method further comprising modifying the voice data as a *function of a predefined characteristic selected by the voice speaker*. However, upon further examining Lerner, Lerner teaches modifying the participant record to store a speech amplitude value where the participant's digitized speech is managed by buffering the amplitude and

comparing to the reference amplitude to store the modified amplitude in the participant record. The modified amplitude is used when the user speaks. Thus it would have been obvious to the skilled artisan at the time of the invention, having the teachings of Ortel and Lerner in front of them, to modify the visual indicator of Ortel to allow the user to manage the voice characteristics of the participant in the multi participant event (See column 2, lines 44-50).

6. **Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ortel et al. (hereinafter Ortel) U.S. Publication No. 20040091086 filed Nov. 8, 2002, in view of Lerner et al. (Hereinafter Lerner) U.S. Patent No. 6192395 issued Feb. 20, 2001, in further view of Blattner et al. (Hereinafter Blattner) U.S. Publication No. 20040221224 Filed Dec. 30, 2003. Please note the provisional applications 60512852, 60464106, 60488399, 60450663 have been reviewed, and the effective filing date of the Blattner reference has been determined to be Nov. 12, 2002.**

With respect to **dependent claims 22 –23**, as indicated in the above discussion, Ortel in view of Lerner teaches every limitation of claim 1.

Ortel in view of Lerner does not expressly teach a method *wherein modifying the voice data as a function of a predefined characteristic selected by the voice speaker comprises adjusting the voice data to sound like an elf and wherein modifying the voice data as a function of a predefined characteristic selected by the voice speaker comprises adjusting the voice data to sound like a pre-selected gender*

Blattner teaches a process of allowing the user to define an avatar to be used during a conference or chat conversation with multiple people and the avatar can provide visual cues to the participants of the conversation based on the programmed characteristic of the owner of the avatar or a predefined operation that the avatar performs. For example, Blattner teaches the avatar can send an automatic hello when someone says "hi" in the chat session to the owner. In other words, the Avatar has a personality much like its owner and through animation the avatar can respond visually to recipients (See Para 014-020). Blattner teaches the user decides which persona to use in responding to a sender (See Para 012), which is a predefined characteristic chosen by the user. Blattner teaches the avatar can have a recorded response, which can be any recordable sound that can be perceived by the user (See Para 0061, 83 and 85) and can be an elf or to sound like a specific gender. Blattner specifically teaches the avatars that represent the buddy on the chat list can comprise animations that possess sound. When the user receives a message the sound is heard along with the animation. Blattner, Ortel and Lerner are multi-person communication systems. They all provide visual indications to the users that reflect status of the user. They also show the ability to allow more than one user to communicate simultaneously.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Blattner, Ortel and Lerner in front of them, to modify the system of Ortel to have the icons modified to include the user voice characteristic modified by Lerner and a recipient's voice respond in a different voice other than the actual voice and to provide a more realistic communications between users as shown in Blattner. The motivation to combine Blattner, Ortel with Lerner comes from the suggestion in Blattner that instant messaging applications can provide visual indications to recipients of messages in a collaborative system where the indications can be programmed or controlled by the user.

7. **Claims 28-29 are rejected under 35 U.S.C 102(e) as being anticipated by Ortel et al. (hereinafter Ortel) U.S. Publication No. 20040091086 filed Nov. 8, 2002, in view of Jenniges et al. (hereinafter Jenniges) U.S. Publication No. 20040203766 filed July 15, 2002.**

With respect to **dependent claims 28-29**, as indicated in the above discussion, Ortel teaches every element of claim 1.

Ortel teaches displaying an icon to give the participant an indication that the second participant is speaking (See Para 40). Ortel however does not suggest that the icons that represent the participant can *display an indicator indicating that a participant can hear voice communications, but does not have microphone and displaying an indicator that the user does not have a voice communicator*. However, Jenniges teaches a system that can display an icon that is representative of the user's communication capability. For example Jenniges teaches a messaging system that provides for presence indicators to indicate that a user is online. The presence indicators also incorporate icons that indicate the user's status and communications capability. The examples shown in figure three provide for an icon that can show the user's preferred type of media (See Para 13). Jenniges and Ortel both teach systems that provide for indicators of participants on conference calls. The indicators provide graphics, status, presences and preferred information that are displayed to the other participants when they are online for the purposes of conveying information to another without directly speaking to them.

Thus it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Ortel and Jenniges in front of them to modify the system of Ortel to display the communications capability to the other participants via an icon. The motivation to combine Ortel with Jenniges comes from the suggestion in Jenniges that a need exists for the users of communications devices to be able to notify the other users of their presence and ability to establish a communication session through visual indicators (See Para 3).

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Response to Arguments

Applicant's arguments with respect to claims 1, 4-10, 12 and 15-29 have been considered but are moot in view of the new ground(s) of rejection.

A reference to specific paragraphs, columns, pages, or figures in a cited prior art reference is not limited to preferred embodiments or any specific examples. It is well settled that a prior art reference, in its entirety, must be considered for all that it expressly teaches and fairly suggests to one having ordinary skill in the art. Stated differently, a prior art disclosure reading on a limitation of Applicant's claim cannot be ignored on the ground that other embodiments disclosed were instead cited. Therefore, the Examiner's citation to a specific portion of a single prior art reference is not intended to exclusively dictate, but rather, to demonstrate an exemplary disclosure commensurate with the specific limitations being addressed. *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)); *In re Upsher-Smith Labs. v. PamLab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005); *In re Fritch*, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992); *Merck & Co. v. Biocryst Labs., Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); *In re Fracalossi*, 681 F.2d 792, 794 n.1, 215 USPQ 569, 570 n.1 (CCPA 1982); *In re Lambert*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976); *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Theriault whose telephone number is (571) 272-5867. The examiner can normally be reached on M, W, F 10:00AM - 8:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven B Theriault/
Patent Examiner
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